

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 40399/177/NIHD

In re patent application of

Jerry M. Keith

Serial No. 07/542,149

Group Art Unit: 1814

Filed: June 22, 1990

Examiner: G. Bugaisky

For: PERTUSSIS TOXIN GENE:
CLONING AND EXPRESSION

RECEIVED

MAR 31 1993

GROUP 180

RECEIVED

MAR 31 1993

GROUP 1800

RESPONSE UNDER 37 CFR §1.111 AND RENEWED REQUEST FOR
INTERFERENCE UNDER 37 CFR §§1.604 AND 1.607

RECEIVED

GROUP 1800

The Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

This paper is responsive to the Official Action
mailed January 14, 1993.

On page 2 of the Official Action, the Examiner notes that, of the pending claims 11-22, claims 17-22 have been withdrawn from consideration as being directed to the invention of non-elected Group II drawn to an antigenic mutant pertussis toxin (see the June 16, 1989 restriction requirement, Application Paper No. 2). Accordingly, reconsideration for claims 11-16, with independent claim 11, is respectfully requested in view of the following remarks.

On pages 2 and 3 of the Official Action, the Examiner deems that the error in inventorship previously asserted by applicant appears to have been inadvertent. The Examiner questions, however, the relationship between the asserted error in inventorship and the statements made in a declaration under 37 CFR § 1.131 by Dr. Jerry Keith to overcome an outstanding Section 102(a) rejection in parent application Serial No. 07/542,149. Specifically, the Examiner questions whether the laboratory work submitted

with the Keith declaration was that of Dr. Keith or Dr. Cieplak. Pending a satisfactory explanation, the Examiner rejected claims 11-16 under 35 USC §102(f).

In fact, the explanation is straightforward. The copies of the notebook pages attached to the Keith declaration are from Dr. Cieplak's own notebook. (See the Declaration by Dr. Cieplak attached to this response.) As stated in applicant's previously-filed petition to amend inventorship, at the time that the invention was made, Dr. Cieplak was working for NIH/NIAID in Dr. Keith's laboratory at the Rocky Mountain Laboratories in Hamilton, Montana. Hence, the statements in the prior Keith declaration are clearly consistent with those recited in the applicant's petition to amend inventorship.

In view of the foregoing explanation, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejection under Section 102(f), and proceed with declaration of an interference, as discussed below.

RENEWED REQUEST FOR INTERFERENCE

Applicant hereby renews his request, in accordance with 37 CFR §§1.604 and 1.607, for an interference between this application and the following patent and applications:

1. U.S. Patent No. 5,085,862 to Klein et al. and any pending continuing applications claiming related subject matter;
2. Application Serial No. 07/094,307 filed September 4, 1987;
3. Application Serial No. 07/232,482 filed August 17, 1988; and

Serial No. 07/542,149

4. Application Serial No. 07/632,265 filed
December 21, 1990.

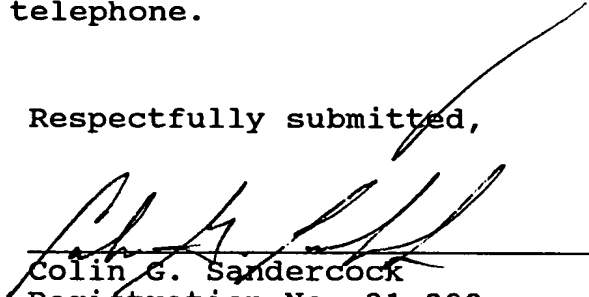
The reasons why such an interference is proper are set forth in applicant's prior request for a declaration of interference filed on October 5, 1992. Applicant's prior request also sets forth a proposed count and the reasons why that proposed count recites a proper basis for the interference.

It is believed that no fees are required for the filing of this paper. If any fees are required, however, the Commissioner is authorized to charge the necessary fees to Deposit Account No. 19-0741. If an extension of time is required, Applicant hereby expressly petitions for same and authorizes the Commissioner to charge the necessary fees to Deposit Account No. 19-0741.

The examiner is courteously invited to contact the undersigned should the examiner have any questions which might be resolved over the telephone.

Respectfully submitted,

3/30/93
Date


Colin G. Sandercock
Registration No. 31,298

FOLEY & LARDNER
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Tel: (202) 672-5300